

REMARKS

In the Office Action mailed June 30, 2004, the oral election of Group I by Mr. Kanzaki in response to the restriction requirement is confirmed. Applicants have cancelled the non-elected claims 21-36 without prejudice. Claims 1-2, 6-12, 16, 18, and 20 are rejected under 35 USC §102(a) as being anticipated by Tosaya et al. (U.S. Patent 6,538,320, hereinafter "Tosaya"). Claims 3-5 and 13-15 are rejected under 35 USC §103(a) as being unpatentable over Tosaya. Finally, claims 17 and 19 are rejected under 35 USC §103(a) as being unpatentable over Tosaya in view of Murayama et al. (US 2001/0009302A1, hereinafter "Murayama").

In response to the rejection of claims 1-2, 6-12, 16, 18, and 20 under 35 USC §102(a) as being anticipated by Tosaya, Applicants have amended independent claims 1 and 11 to indicate that a foot portion extends from the top of the conductive lid. In particular, claim 1 as amended comprises "a foot portion extending from the top of said conductive lid to a surface adapted to be coupled to a substrate of said integrated circuit." Similarly, claim 11 comprises "a conductive lid having a foot portion extending from a top of said conductive lid and comprising at least one through-hole." Applicants respectfully submit that independent claims 1 and 11 as amended distinguish Applicants' invention over the cited art. Applicants further submit that dependent claims 2-10 and 12-20 are allowable for at least the same reasons that independent claims 1 and 11, respectively, are believed allowable.

In response to the suggestion in the Office Action that the limitations in claims 6 and 7 would not carry patentable weight, Applicants respectfully submit that the claims clearly provide patentable limitations in view of the amendment to independent claim 1. While a product-by-process claim may not be patentable if the product in the claim is the same as or obvious from the prior art product, the structure of Applicants' invention as set forth in independent claim 1 as amended clearly distinguishes

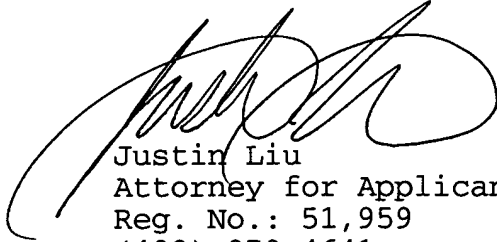
Applicants' invention over the cited art. Accordingly, dependent claims 6 and 7 also provide patentable limitations.

In response to the rejection of claims 3-5 and 13-15 under 35 USC §103(a) as being unpatentable over Tosaya, Applicants submit that the claims are allowable for at least the same reasons that independent claims 1 and 11 are believed allowable. Further, in response to the suggestion in the Office Action that claims 3-5 and 13-15 are obvious because "applicant has not disclosed that these shapes provide an advantage, [are] used for a particular purpose, or solve a stated problem," Applicants note that the purposes and advantages to their structure are disclosed in the specification, for example paragraph [0019]. In particular, Applicants state that the shape of holes can be tapered, with the top generally larger in diameter to improve the adhesive effect of the through-hole. (Para. [0019], lines 4-7). Applicants further state that the larger diameter at the top a tapered through-hole (such as a conical through-hole or a through-hole having a first cylindrical portion and a second cylindrical portion) acts like a head of a screw or nail to prevent the separation of the metal lid from the package. (Para. [0019], lines 14-16). Accordingly, while the independent claims distinguish the invention over the cited art, the shapes of the holes (and not particular dimensions) provide additional patentable limitations in dependent claims 3-5 and 13-15 distinguishing Applicants' invention over the cited art.

In response to the rejection of claims 17 and 19 under 35 USC §103(a) as being unpatentable over Tosaya in view of Murayama, Applicants respectfully request reconsideration. Applicants submit that Murayama fails to overcome the deficiency of the primary reference (i.e., failing to disclose a through-hole extending from the top of the conductive lid), and any combination of the references would not lead to Applicants' invention as claimed.

For the reasons set forth above, Applicants submit that the claims as amended are allowable over the cited art and respectfully requests reconsideration. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on September 30, 2004.

Julie Matthews  
Name

  
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